

### **REMARKS/ARGUMENTS**

This Amendment is being filed in response to a final Official Action dated July 25, 2008, for the above-identified patent application. Initially, Applicants note that, on its face, the final Official Action rejects Claims 1, 2, 6-8, 12-14, 18, 19, 23, 24, 28, 29, 33, 34, 38, 39 and 43-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,228,425 to Staring et al., in view of newly-cited U.S. Patent No. 7,092,524 to Timmel. During a brief telephone conference between the Examiner and Applicants' undersigned attorney on August 5, 2008, however, the Examiner confirmed that Claims 7, 8, 18, 19, 28, 29, 38, 39 and 43-45 should instead be rejected under 35 U.S.C. § 103(a) as being unpatentable over Staring, in view of newly-cited U.S. Patent Application Publication No. 2005/0076063 to Andoh.

In view of the above, Applicants understand Claims 1, 2, 6, 12-14, 23, 24, 33 and 34 stand rejected as being unpatentable over Staring, in view of Timmel; and Claims 7, 8, 18, 19, 28, 29, 38, 39 and 43-45 stand rejected as being unpatentable over Staring, in view of Andoh. The Official Action then rejects the remaining claims, namely Claims 3-5, 9-11, 15-17, 20-22, 25-27, 30-32, 35-37 and 40-42, as being unpatentable over Staring in view of Timmel, and further in view of U.S. Patent Application Publication No. 2004/0133794 to Kocher et al., or U.S. Patent Application Publication No. 2002/0152262 to Arkin et al. That is, the Official Action rejects Claims 3, 5, 9-11, 15, 17, 20-22, 25, 27, 30-32, 35, 37 and 40-42 as being unpatentable over Staring in view of Timmel, and further in view of Kocher; and rejects Claims 4, 16, 26 and 36 as being unpatentable over Staring in view of Timmel, and further in view of Arkin.

As explained below, Applicants respectfully submit that the finality of the present Official Action is premature, and that the claimed invention is patentably distinct from Staring, Andoh, Timmel, Kocher and Arkin, taken individually or in any proper combination. Nonetheless, Applicants have cancelled Claims 1-6, 13-17, 23-27 and 33-37 to most expeditiously advance prosecution of the present application. Before addressing the finality of the Official Action and patentability of the claims over the cited references, however, Applicants first address below the "statement of use" issue raised in the response to arguments section of the final Official Action. In view of the cancellation of claims and the remarks presented herein,

Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application. Alternatively, as neither the cancellation of claims nor the remarks presented herein raise any new issues or introduce any new matter, Applicants respectfully request entry of this Amendment for purposes of narrowing the issues upon appeal.

### ***I. Functional Claim Language***

Initially, Applicants note that in the response to arguments section of the Official Action, the Official Action appears to be suggesting a “statement of use” argument for discounting recitations of the claims. Official Action of July 25, 2008, page 2. In contrast to the allegation of the Official Action, however, Applicants respectfully submit that functional language, such as “configured to,” is definite and acceptable claim language. Section 2173.05(g) of the MPEP defines a functional limitation as “an attempt to define something by what it does, rather than what it is (e.g., as evidenced by its specific structure or specific ingredients).” In this regard, a functional limitation is often used in association with an element to “define a particular capability or purpose that is served by the recited element, ingredient or step.” *Id.* More particularly, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) has held that the limitations “adapted to be fitted,” “adapted to be affixed” and “adapted to be positioned,” “serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.” MPEP § 2173.05(g), *citing In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976) (emphasis added).

Moreover, and more particularly with respect to similar functional language, “configured to,” Applicants note that it has been held that an apparatus configured (e.g., programmed) to perform various steps or functions creates a new apparatus. *See In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994); and *see id.* at 1569-1570 (Newman, concurring) (“Alappat’s rasterizer is an electronic device for displaying a smooth waveform by selective illumination of pixels. The Alappat rasterizer operates by performing a sequence of steps in accordance with instructions that are generated electronically. ... The structure resides in the configuration by which the device operates, as [the majority] has explained, and is independent of how that configuration is provided.”) (emphasis added).

Applicants therefore respectfully submit that to the extent the claims of the present application include structure positively performing various functions, or include components configured to perform various functions, those limitations must be evaluated and considered like any other claim limitation, and that to anticipate such limitations, the prior art must explicitly or inherently disclose those limitations.

## ***II. Finality of the Official Action is Premature***

In the first Official Action dated January 17, 2008, the Examiner rejected original independent Claims 7, 18, 28 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Staring in view of Kocher, and further in view of U.S. Patent No. 6,278,678 to Iida. As to original independent Claims 7, 18, 28 and 38, the first Official Action conceded that Staring did not teach or suggest modifying a file allocation table entry,” and instead attributed this feature to Iida. In Applicants’ response to the first Official Action, however, Applicants traversed this rejection and explained that like Staring, Iida (as well as Kocher) also does not teach or suggest the file allocation table entry modification feature of original independent Claims 7, 18, 28 and 38. Applicants did slightly amend independent Claims 7, 18, 28 and 38, but did not do so relative to the aforementioned file allocation table entry modification feature.

Now, in the final Official Action, the Examiner no longer rejects any of independent Claims 7, 18, 28 and 38 as being unpatentable over Staring in view of Kocher, and further in view of Iida. Instead, the final Official Action rejects all of those independent claims as being unpatentable over Staring, in view of Andoh, now alleging that Andoh discloses the very feature the first Official Action attributed to Iida.

In accordance with MPEP § 706.07(a), a second or subsequent Official Action shall be made final, “except where the examiner introduces a new ground of rejection that is neither necessitated by applicants’ amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p).” In the instant case, the Examiner in the final Official Action alleges that the newly-cited Andoh discloses the feature of modifying a file allocation table entry, per original and currently-pending independent Claims 7, 18, 28 and 38. By this change

with respect to at least independent Claims 7, 18, 28 and 38, the Examiner has introduced a new ground of rejection neither necessitated by Applicants' claim amendments presented in response to the first Official Action, nor based on information submitted in an IDS filed after that Official Action. While Applicants do acknowledge amending independent Claims 7, 18, 28 and 38, Applicant respectfully submits that none of the amendments made to any of those claims "necessitated the new ground(s) of rejection" in the final Official Action.

Applicants therefore respectfully submit that in the current Official Action, the Examiner introduced a new ground of rejection that was neither necessitated by Applicants' amendment of at least independent Claims 7, 18, 28 and 38 nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c). Applicants also respectfully submit that, in accordance with MPEP § 706.07(a), the Examiner prematurely issued a final Official Action. Accordingly, Applicants respectfully request withdrawal of the finality of the current Official Action.

### ***III. The Claimed Invention is Patentable over the Cited References***

Various ones of the claims of the present application are separately rejected as being unpatentable over various combinations of Staring, Andoh, Timmel, Kocher and Arkin. Accordingly, the rejections of the claims will be separately addressed below in a similar fashion.

#### ***A. Claims 1, 2, 6, 12-14, 23, 24, 33 and 34 are Patentable***

The Official Action rejects Claims 1, 2, 6, 12-14, 23, 24, 33 and 34 as being unpatentable over Staring, in view of Timmel. In view of Applicants cancellation of Claims 1-6, 13-17, 23-27 and 33-37, Applicants respectfully submit that this rejection is largely moot. As explained in response to the first Official Action with respect to dependent Claim 12, however, Applicants note that by its dependency to independent Claim 7, dependent Claim 12 recites modifying a file allocation table entry and extracting the file allocation table entry from the modified entry. Nowhere, however, does the final Official Action assert that either Staring or Timmel teach or suggest this feature of independent Claim 7 (noting that on its face the Official Action does cite Timmel for disclosing this feature, but that as confirmed by the Examiner, this attribution should

instead be to Andoh). And as explained below, independent Claim 7, and by dependency Claim 12, is patentably distinct from Staring and Andoh (as well as Timmel), taken individually or in any proper combination.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1, 2, 6, 12-14, 23, 24, 33 and 34 as being unpatentable over Staring, in view of Timmel is moot or otherwise overcome.

***B. Claims 7, 8, 18, 19, 28, 29, 38, 39 and 43-45 are Patentable***

The Official Action rejects Claims 7, 8, 18, 19, 28, 29, 38, 39 and 43-45 as being unpatentable over Staring, in view of Andoh. According to one aspect of the present invention, as reflected by independent Claim 7 for example, a system is provided that includes an apparatus, and first and second network entities. The apparatus is configured to receive content and store the content in memory. The first network entity is configured to operate a download manager that is configured to modify a file allocation table (FAT) entry of content stored by the apparatus to thereby increase a perceived size of the content. The second network entity, then, is configured to operate a file manager that, upon request for the received content, is configured to extract the entry of the received content from the modified file allocation table entry, and thereafter assemble the received content from the file allocation table entry of the received content.

In contrast to independent Claim 7, neither Staring nor Andoh (nor Timmel, Kocher or Arkin), taken individually or in any proper combination, teach or suggest a system for protecting content including modifying a file allocation table entry of content stored by the apparatus to thereby increase a perceived size of the content, and extracting the file allocation table entry from the modified file allocation table entry. The Official Action seemingly concedes that Staring does not teach or suggest this feature, but alleges that Andoh does disclose the feature, and that one skilled in the art would have been motivated to modify Staring per Andoh to teach the claimed invention. Applicants respectfully disagree, however, and submit that like Staring, Andoh (as well as Timmel, Kocher and Arkin) also does not teach or suggest the aforementioned

file allocation table entry modification and extraction features; nor does the Official Action adequately support the alleged combination of Staring and Andoh.

**1. File Allocation Table Entry Modification and Extraction**

Briefly, Andoh discloses a file system for enabling the restoration of a defective file produced as a result of an unexpected stoppage of recording data for that file to memory. As disclosed, when data is recorded to memory, an initial value of the corresponding file size (file size = 0) is written to a directory of the file system; and when the recording is finished, the actual file size is written to the directory (file size > 0). *See* Andoh, Abstract. According to Andoh, when recording data is unexpectedly stopped, such as due to a power failure, the actual file size may not be written to the directory, thereby leaving in place the initial value of the file size. Thus, a defective file may be detected if the file size is maintained as the initial value. *See id.*, paragraph [0050].

In view of the foregoing, one could argue that Andoh discloses modifying the directory entry for a file from an initial value of its size (file size = 0) to an actual value of its size (file size > 0), this operation being performed during recording the file to memory. This modification, however, is not performed to increase a perceived size of the file, similar to modification of the file allocation table (FAT) entry according to independent Claim 7. Rather, as clearly disclosed by Andoh, its modification is performed to reflect the actual size of the file. Andoh therefore also does not teach or suggest extracting the directory entry (size = 0) from its modified directory entry (size > 0), similar to the file manager of independent Claim 7 extracting the FAT entry from the modified FAT entry.

**2. No Apparent Reason to Modify Staring per Andoh**

Applicants note that even if one could argue that Staring and Andoh disclose respective elements of independent Claim 7, the Official Action does not provide a sufficient reason for their combination. Initially, Appellants acknowledge the Supreme Court's recent decision in which the Court rejected a rigid application of the "teaching, suggestion or motivation" (TSM) test. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007).

Nonetheless, in *KSR Int'l. Co.*, the Court did state that obviousness often requires determining whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue, and that to facilitate review, this analysis should be made explicit. *See KSR Int'l. Co.*, 127 S.Ct. at 1740–41, 82 USPQ2d (BNA) at 1396. Even further, the Court noted that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S.Ct. at 1740–41, 82 USPQ2d (BNA) at 1396, *citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d (BNA) 1329 (Fed. Cir. 2006) (emphasis added).

As clearly explained by the Supreme Court in *KSR Int'l. Co.*, then, any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. In the instant case, the Examiner attempts to support the alleged modification of Staring per Andoh, by merely asserting an alleged benefit of Staring alone, and by asserting an alleged feature of Andoh (without any assertion as to why it would have been obvious to modify Staring to include that feature of Andoh). Further, nowhere does the Examiner support the aforementioned conclusion with any reasoning or with some rationale underpinning the conclusion, whether in the nature of the problem to be solved, any of the cited references, or knowledge of those skilled in the art. And in line with the Court in *KSR Int'l. Co.*, the obviousness rejection of the present claims cannot be sustained by merely concluding that one skilled in the art would have found it obvious to modify Staring per Andoh due to a feature already provided by Staring, and due to the sole existence of an alleged feature of Andoh.

Applicants therefore respectfully submit that independent Claim 7, and by dependency Claims 8-12 and 43, is patentably distinct from Staring and Andoh (as well as Timmel, Kocher and Arkin), taken individually or in any proper combination. Applicants also respectfully submit that independent Claims 18, 28 and 38 recite subject matter similar to that of independent Claim 1, including the aforementioned modifying a file allocation table entry feature. As such, Applicants respectfully submit that independent Claims 18, 28 and 38, and by dependency Claims 19-22, 29-32, 39-42 and 44-46, are also patentably distinct from Staring, Andoh (as well

as Timmel, Kocher and Arkin), taken individually or in any proper combination, for at least the reasons given above with respect to independent Claim 7.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 7, 8, 18, 19, 28, 29, 38, 39 and 43-45 as being unpatentable over Staring, in view of Andoh is overcome.

***C. Claims 3, 5, 9-11, 15, 17, 20-22, 25, 27, 30-32, 35, 37 and 40-42 are Patentable***

The Official Action rejects Claims 3, 5, 9-11, 15, 17, 20-22, 25, 27, 30-32, 35, 37 and 40-42 as being unpatentable over Staring in view of Timmel, and further in view of Kocher. In view of Applicants cancellation of Claims 1-6, 13-17, 23-27 and 33-37, Applicants respectfully submit that this rejection is also largely moot. In a manner similar to that explained above with respect to dependent Claim 12, however, Applicants note that by its dependency to independent Claim 7 or similarly independent Claims 18, 28 and 38, dependent Claims 9-11, 20-22, 30-32 and 40-42 recite modifying a file allocation table entry and extracting the file allocation table entry from the modified entry. Nowhere, however, does the final Official Action assert that any of Staring, Timmel or Kocher teach or suggest this feature of independent Claims 7, 18, 28 or 38 (noting that on its face the Official Action does cite Timmel for disclosing this feature, but that as confirmed by the Examiner, this attribution should instead be to Andoh). And as explained above, independent Claims 7, 18, 28 and 38, and by dependency Claims 9-11, 20-22, 30-32 and 40-42, are patentably distinct from Staring and Andoh (as well as Timmel and Kocher), taken individually or in any proper combination.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 3, 5, 9-11, 15, 17, 20-22, 25, 27, 30-32, 35, 37 and 40-42 as being unpatentable over Staring in view of Timmel, and further in view of Kocher is moot or otherwise overcome.

***D. Claims 4, 16, 26 and 36 are Patentable***

The Official Action rejects Claims 4, 16, 26 and 36 as being unpatentable over Staring in view of Timmel, and further in view of Arkin. Once again, in view of Applicants cancellation of Claims 1-6, 13-17, 23-27 and 33-37, Applicants respectfully submit that this rejection is moot.



Appl. No.: 10/701,087  
Amdt. dated 08/25/2008  
Reply to Official Action of July 25, 2008

**CONCLUSION**

In view of the cancellation of claims and the remarks presented herein, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Amendment, and as such, Applicants alternatively respectfully request entry of this Amendment for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Andrew T. Spence  
Registration No. 45,699

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111  
LEGAL02/30904087v1

**ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON August 25, 2008.**